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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,816	06/18/2001	W. Reed Hastings	56055-0013	5101

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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/884,816

Applicant(s)

HASTINGS ET AL.

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 28-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/18, 2/12, 10/6</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 25-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 19, 2004.

However, because the applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-24 and 28-41 are rejected as set forth below.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-41 are rejected under 35 U.S.C. 112 second paragraph.

Referring to claims 39-41. Claims 39-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims.

Claim Rejections - 35 USC § 101

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 101 that form the basis for the rejections under this section made in this Office action:

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 and 39-41 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Referring to claims 1-12. The invention as recited in the claims is merely an abstract idea that is not within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful

Art Unit: 3625

arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter.

Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. "A computer-implemented method for estimating..., etc." mere nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not affect or affect the underlying process.

Referring to claims 39-41. Claims 39-41 do not set forth a proper process. Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975). One cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 and 28-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Chislenko U.S. Patent Number 6,041,311.

Referring to claim 1. Chislenko discloses a computer-implemented method for estimating how a user would rate an item that the user has not yet rated, the method comprising the steps of:

- Identifying one or more items that have been rated by the user (Chislenko: column 3, lines 38-57, "Each user profile associates items with the ratings given to those items by the user.");
- Identifying one or more other users that have rated the one or more items (Chislenko: column 4, lines 56-65, "Each item profile records how particular users have rated this particular item.") and given ratings to the one or more items that are substantially similar to ratings given by the user to the one or more items (Chislenko: column 2, lines 40-54); and

- Estimating how the user would rate the item that the user has not yet rated based upon how the one or more other users rated the item (Chislenko: column 2, lines 20-30: "The ratings given to items by the neighboring users as well as the weights assigned to those neighboring users are then used to predict ratings and to make recommendations of items that the user has not yet rated.").

Referring to claim 2. Chislenko further discloses a method wherein the step of identifying one or more items that have been rated by the user includes identifying one or more items that have been rated favorably by the user (Chislenko: column 8, lines 19-34).

Referring to claim 3. Chislenko further discloses a method wherein the ratings given by the user to the one or more items satisfy a minimum rating threshold (Chislenko: column 9, line 62 to column 10, line 6).

Referring to claim 4. Chislenko further discloses a method wherein the step of identifying one or more other users that have rated the one or more items and given ratings to the one or more items that are substantially similar to ratings given by the user to the one or more item includes identifying one or more other users that have rated the one or more items and given ratings to the one or more items that are within a specified amount of ratings given by the user to the one or more items (Chislenko: column 9, line 62 to column 10, line 6).

Referring to claim 5. Chislenko further discloses a method wherein the step of identifying one or more other users that have rated the one or more items and given ratings to the one or more items that are within a specified amount of ratings given by

Art Unit: 3625

the user to the one or more items includes for each item from the one or more items, determining whether the rating given by the one or more other users is within a specified amount of the rating given by the user (Chislenko: column 9, line 62 to column 10, line 6).

Referring to claim 6. Chislenko further discloses a method wherein the step of identifying one or more other users that have rated the one or more items and given ratings to the one or more items that are within a specified amount of ratings given by the user to the one or more items includes determining whether an average of the ratings given by the one or more other users to the one or more items is within a specified amount of an average of the ratings given by the user to the one or more items (Chislenko: column 7, lines 13-28).

Referring to claim 7. Chislenko further discloses a method wherein the step of estimating how the user would rate the item that the user has not yet rated based upon how the one or more other users rated the item includes comparing the ratings given by the one or more other users to the one or more items to ratings given by the one or more other users to the item that the user has not yet rated (Chislenko: column 2, lines 20-30).

Referring to claim 8. Chislenko further discloses a method wherein the step of comparing the ratings given by the one or more other users to the one or more items to ratings given by the one or more other users to the item that the user has not yet rated includes comparing an average of the ratings given by the one or more other users to

Art Unit: 3625

the one or more items to ratings given by the one or more other users to the item that the user has not yet rated (Chislenko: column 7, lines 13-28).

Referring to claim 9. Chislenko further discloses a method wherein the item is a movie and the one or more items are one or more movies (Chislenko: column 3, lines 5-15).

Even though Chislenko discloses a method according to claim 9 as indicated supra, the Examiner notes, data identifying a particular item type is not functionally related to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1391, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to claim 10. Chislenko further discloses a method wherein the item is a game and the one or more items are one or more games (Chislenko: column 3, lines 5-15).

Even though Chislenko discloses a method according to claim 10 as indicated supra, the Examiner notes, data identifying a particular item type is not functionally related to the substrate of the method. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1391, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Referring to claim 11. Chislenko further discloses a method wherein the item is a rental item (Chislenko: column 3, lines 5-15).

Art Unit: 3625

Referring to claim 12. Chislenko further discloses a method wherein the number of items in the one or more items is at least a specified number of items (Chislenko: column 10, lines 15-31).

Referring to claims 13-24. Claims 13-24 are rejected under the same rationale as set forth above in claims 1-12.

Referring to claims 28-38. Claims 28-38 are rejected under the same rationale as set forth above in claims 1-12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/884,816

Page 10

Art Unit: 3625

A handwritten signature in black ink, appearing to be the initials 'MSG' followed by a stylized flourish.

MSG

Patent Examiner

October 29, 2004